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OFFICE OF PETITIONS

In re
O'Connell, et al.
Application No. 09/954,677
Filed: September 15, 2001
Patent No. 6,957,908
Issued: October 25, 2005
Attorney Docket No. 061300-0242

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
: AND PETITION TO SUSPEND
: THE RULE UNDER
: 37 C.F.R. § 1.183

This letter is in response to the "SECOND REQUEST FOR RECONSIDERATION OF PREVIOUS APPLICATION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b) IN THE ALTERNATIVE: PETITION FOR SUSPENSION OF RULES UNDER 37 C.F.R § 1.183", filed January 31, 2006. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to six hundred forty-three (643) days. In the alternative, patentees request the suspension of 37 C.F.R. § 1.704(c)(3).

The application for patent term adjustment is DISMISSED.

Procedural History / Background:

On March 30, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days. On June 24, 2005, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is six hundred forty-three (643) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of six hundred forty-three (643) days, pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by eight hundred thirty-five (835) days of Applicant delay pursuant to 37 C.F.R. § 1.704(c)(3).

A Notice to File Missing Parts was mailed on October 16, 2001. Applicants failed to timely reply. Accordingly, the application became abandoned on December 17, 2001. A petition to revive was first filed on January 9, 2004, and was finally granted in a decision mailed on April 30, 2004.

In their application for patent term adjustment filed June 24, 2005, Applicants stated that the Office mailed a Withdrawal of Previously Sent Notice on July 29, 2004, indicating that the Notice of Abandonment mailed on November 10, 2003 was mailed in error. However, the application for patent term adjustment was dismissed in a decision mailed on September 1, 2005. The decision pointed out that a review of the application file failed to reveal the presence of a Withdrawal of Previously Sent Notice.

On renewed petition filed September 28, 2005, applicants supplied the Office with a copy of the July 29, 2004 Withdrawal of Previously Sent Notice. However, a further review of the record revealed that the Withdrawal of Previously Sent Notice was in fact mailed in error. The application was properly abandoned on December 17, 2001. The Notice to File Missing Parts mailed October 16, 2001 was properly mailed to the address of record

¹ Applicant filed the application for patent term adjustment on the same date as the issue fee.

(James A. Wilke, Foley & Lardner, Firststar Center, 777 East Wisconsin Avenue, Milwaukee, WI 53202-5367).

The Office mailed a decision dismissing applicants' renewed petition on December 2, 2006. The decision pointed out that rather than file a petition to withdraw the holding of abandonment due to non-receipt of the Notice to File Missing Parts, applicants filed a petition to revive the application under 37 C.F.R. § 1.137(b) on January 9, 2004.² The petition was granted in a decision mailed on April 30, 2004. The decision revived the application under 37 C.F.R. § 1.137(b); it did not *sua sponte* withdraw the holding of abandonment.

37 C.F.R. § 1.704(c)(3) states:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

(i) **The date of mailing of the decision reviving the application** or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed; (emphasis added)

Therefore, the December 2, 2005 decision stated that applicants should have been assessed delay for the period from December 17, 2001 (the date the application became abandoned) to

² A petition to revive an abandoned application should not be confused with a petition to withdraw the holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, controlling dates, or applicant contends he did not receive an Office action), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. Where there is no dispute as to whether an application is abandoned (e.g. the applicant's contentions merely involve the cause of abandonment), a petition under 37 CFR 1.137 is necessary to revive the abandoned application.

April 30, 2004 (the date of mailing of the decision reviving the application), or 865 days, not 835 days. Accordingly, the decision held that the correct determination of patent term adjustment was **zero (0) days** (643 days of PTO delay, reduced by 865 days of applicant delay).

The Instant Request for Reconsideration:

Patentees assert that under MPEP 711.03(c)(II), a petition to revive an abandoned application or a petition to withdraw a holding of abandonment is an effective method of "overcoming abandonment" of an application when an Office action is not received by the applicant. In addition, patentees state that in this instance when they filed their grantable 37 C.F.R. § 1.137(b) petition, the "basis for overcoming abandonment" was that the Notice to File Missing Parts was not received by applicants. Lastly, patentees state they consulted with a USPTO employee on November 13, 2003, who suggested that the applicants filed a petition to revive the abandoned application. Patentees' arguments have been considered, but are not persuasive. After discussing the procedures for filing a petition to withdraw the holding of abandonment based upon failure to receive an Office action, MPEP 711.03(c)(II) states:

Two additional procedures are available for **reviving** an application that has become abandoned due to **failure to reply to an Office Action**: (1) a petition under 37 CFR 1.137(a) based on unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.³

In fact, MPEP 711.03(c)(I) specifically states that where an applicant contends that the application is not in fact abandoned (for example, because applicant never received an Office action), "a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action." Accordingly, when an application becomes abandoned and the applicant contends that he never received the Office action, he should file a petition to withdraw the holding of abandonment, together with the required showing. "If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action."⁴

³ Emphasis added.

⁴ MPEP 711.03(c)(II).

However, if applicant can not provide the required showing of nonreceipt, then applicant may file a petition to revive the abandoned application. 37 C.F.R. § 1.137(b) requires no showing at all, merely "a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional". Accordingly, when patentees states that the "basis for overcoming abandonment" was that the Notice to File Missing Parts was not received, patentees are incorrect. The Office granted the 37 C.F.R. § 1.137(b) petition because applicants paid the petition fee, submitted the required reply, and made the proper statement of unintentional delay - **not** because applicants successfully demonstrated that they failed to receive the Notice to File Missing Parts.

Lastly, patentees state that they filed the 37 C.F.R. § 1.137(b) petition upon the suggestion of a USPTO employee. Patentees are directed to MPEP 711.03(c)(III)(C)(2), which cautions applicants not to rely upon oral advice from USPTO employees. See also 37 C.F.R. § 1.2.

Petition to Suspend 37 CFR 1.704(c)(3):

37 C.F.R. § 1.183 states:

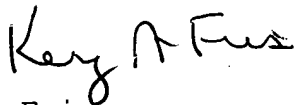
In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

Petitioner has not demonstrated that this is an extraordinary situation where justice requires waiver of the rules. The instant scenario is one that could have been avoided with the reasonable exercise of due care. Applicants chose to revive the application pursuant to 37 C.F.R. § 1.137(b), rather than demonstrate that they did not receive the Notice to File Missing Parts by filing a grantable petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181.

Effective December 8, 2004, the fee for a petition under 37 C.F.R. § 1.183 was increased to \$400. See § 1.17(f).

Petitioner submitted \$130. However, as petitioner included an authorization to charge any additional fees to his deposit account, \$270 has been charged to Deposit Account No. 06-1447, as authorized.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

A handwritten signature in cursive script, appearing to read "Kery Fries".

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy